

REMARKS

In the previous detailed action mailed October 28, 2002, the Examiner rejected all claims 1-26 under 35 U.S.C. § 103(a) as being unpatentable over multiple references including the ParkStone, Menduno, and med-I-nets references. In response, the Applicants submitted declarations of the inventors Richard Fiedotin, Jeffery Tangney, Thomas Lee, and attorney Dion M. Bregman, along with supporting Exhibits, under 37 C.F.R. § 1.131. In particular, the Declaration of Richard Fiedotin included Exhibits A-O which presented evidence of diligent activity toward the actual reduction to practice of the present invention from prior to July 1, 1999 to at least September 16, 1999.

The Examiner accepted the Declaration of Dion M. Bregman as sufficient to establish attorney diligence in constructively reducing the invention to practice between the dates of September 16, 1999 and the filing date of the instant application. The Examiner also accepted the Declarations of Richard Fiedotin, Jeffery Tangney, and Thomas Lee as sufficient to overcome the Parker reference. However, the Examiner alleges that the Declarations of Richard Fiedotin, Jeffery Tangney, and Thomas Lee are insufficient to establish due diligence in reducing the invention to practice from prior to July 1, 1999 to at least September 16, 1999. Specifically, the Examiner has alleged the previously submitted Declarations fail to establish due diligence during the following periods:

- I. July 30, 1999 - August 6, 1999
- II. August 31, 1999 - September 7, 1999; and September 7, 1999 - September 15, 1999.¹

As will be shown below, the inventors were indeed diligent in reducing the invention to practice throughout the period from July 1, 1999 to September 16, 1999. Evidence of such diligence can be found in both the previously submitted Declarations and supporting Exhibits, as well as in the presently submitted supplemental Declaration and supporting Exhibits. Previously submitted Exhibits F, O, and K are appended in *Appendix A* for ease of reference. Richard Fiedotin's Supplemental Declaration and supporting Exhibits P and Q, are appended hereto in *Appendix B*.

¹ See page 2 – page 3, of the 6/20/03 Detailed Action.

The applicant will now address each period raised by the Examiner in turn.

I. July 30, 1999 - August 6, 1999

Exhibits F and J, originally filed with the response to the office action mailed October 28, 2002, (appended hereto in *Appendix A*) show evidence of diligence of reduction to practice of the present invention on July 30, 1999. In particular, Exhibit F, is a copy of an invoice from BlueLark Interactive, LLC billed to nCircle (now ePocrates) for services rendered in developing software code that performs at least part of the claimed invention. The invoice shows that on July 30, 1999, BlueLark Interactive LLC spent 7.5 hours in a Design Meeting relating to the ePocrates code. In addition, Exhibit J, (also appended hereto in *Appendix A*) is a page from Richard Fiedotin's inventor's notebook with an entry dated July 30, 1999, showing contact with Pfizer Inc.®, a leading drug developer and manufacturer. Therefore, these Exhibits provide evidence of diligence on July 30, 1999.

Richard Fiedotin's Supplemental Declaration and supporting Exhibit P, shows diligence during the period between at least August 2, 1999 - August 5, 1999 (it is noted that July 31, 1999 and August 1, 1999 fell on a Saturday and Sunday). Exhibit P contains Richard Fiedotin's detailed notes from his planning, product development, and business meetings with multiple different entities related to development of the invention. Such meetings, planning, and business partnering with different entities formed an important part of reducing the invention to practice, as these entities generate and supply medical data. The use of such medical data is required by the claims of the present invention. Therefore, Exhibit P provides evidence of diligence from at least August 2, 1999 to at least August 6, 1999. Please note that portions of Exhibit P have been redacted for confidentiality purposes, and, therefore, only the dates in question are presented. Therefore, this Exhibit provides evidence of diligence from at least August 2, 1999 - August 6, 1999.

II. August 31, 1999 - September 7, 1999, and September 7, 1999 - September 15, 1999

Returning to the previously submitted Exhibit K, (appended hereto in *Appendix A*) which provided a sampling of some of the first 2,000 code revisions made during the period between at least August 6, 1999 - September 21, 1999. The first 15 of these revisions correspond to the period between August 6, 1999 to August 8, 1999, followed by: revision number 20 on

August 8, 1999; revision number 25, 30, and 40 on August 9, 1999; *etc.* In other words, the revisions previously presented to the Examiner were a sampling of dates up to revision number 1,600 that was made on September 17, 1999.

Richard Fiedotin's Supplemental Declaration and its supporting Exhibit Q provide evidence of additional code revisions from August 12, 1999 - September 13, 1999. More specifically, evidence is provided of the following code revisions: code revision entry number 250, occurring on August 12, 1999; revision entry number 380, occurring on August 16, 1999; revision entry number 420, occurring on August 19, 1999; revision entry number 440, occurring on August 20, 1999; revision entry number 466, occurring on August 23, 1999; revision entry number 470, occurring on August 24, 1999; revision entry number 550, occurring on August 26, 1999; revision entry number 570, occurring on August 27, 1999; revision entry number 720, occurring on August 30, 1999; revision entry number 825, occurring on September 1, 1999; revision entry number 830, occurring on September 2, 1999; revision entry number 850, occurring on September 3, 1999; revision entry number 950, occurring on September 6, 1999; revision entry number 1050, occurring on September 8, 1999; revision entry number 1120, occurring on September 10, 1999; and revision entry number 1170, occurring on September 13, 1999. Therefore, these Exhibits provide evidence of diligence from at least August 12, 1999 - September 13, 1999.

The Examiner has also alleged that the response to the office action mailed October 28, 2002, failed to establish diligence on both September 14, and September 15, 1999. Previously submitted Exhibit K, (appended hereto in *Appendix A*) includes evidence of diligence of actual reduction to practice on both of these dates. More specifically, Exhibit K shows the following code revisions: revision number 1,200 occurred on September 14, 1999; and revision number 1,300 occurred on September 15, 1999. Therefore, this Exhibit provides evidence of diligence on both September 14, and September 15, 1999. All code revisions formed part of reducing the claimed invention to practice.

CONCLUSION


In light of the above, all of the dates that the Examiner has objected to as lacking evidence of due diligence have been accounted for between the Declarations and supporting Exhibits originally filed with the response to the office action mailed October 28, 2002, and the

Supplemental Declaration and supporting Exhibits currently submitted. Therefore, it is respectfully requested that the rejection of the claims be withdrawn and the claims allowed.

No fee is believed due at this time, however, if a fee is due authorization is given to charge such fee to Pennie & Edmonds LLP Deposit Account No. 16-1150, order no. 10160-007-999. The Examiner is encourages to call the undersigned attorney at (650) 849-7603, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date: September 22, 2003

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